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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/128,718	08/04/1998	MICHAEL J. HELLER	236/092	3306

34263 7590 12/02/2005

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EXAMINER
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MORAN, MARJORIE A

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/128,718

Applicant(s)

HELLER ET AL.

Examiner

Marjorie A. Moran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 41-43 and 49-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41-43 is/are allowed.
- 6) ☒ Claim(s) 49-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/31/01</u> . | 6) <input type="checkbox"/> Other: _____  |

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In view of the new grounds of rejection set forth below, the suspension of prosecution indicated in a communication mailed 11/3/04 is hereby withdrawn and prosecution on the merits of pending claims 41-43 and 49-51 is re-opened.

***Information Disclosure Statement***

The information disclosure statement filed 12/31/01 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e) or a fee as set forth in 37 CFR 1.17(p). It has been placed in the application file, but the information referred to therein has not been considered.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 49-51 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by HOLLIS et al. (IDS ref: US 5,653,939, filed 11/19/1991).

Claims 13-15 (col. 22, lines 42-63) of HOLLIS are identical to instant claims 49-51, therefore HOLLIS anticipates claims 13-15. It is noted that applicant has copied claims from the HOLLIS patent in order to provoke an interference. However, the

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priority date of the HOLLIS patent (11/19/1991) significantly predates the priority date of the instant application (11/1/1993) and no statement has been filed under 35 CFR 41.202 or 41.204, therefore the instant claims are rejected over claims 13-15 of HOLLIS.

Claims 49-51 are rejected under 35 U.S.C. 102(e) as being anticipated by HOLLIS et al. (US 5,846,708, filed 11/18/1991).

HOLLIS teaches an apparatus for synthesizing structures in situ comprising a test site array with separate wells each containing electrodes for attracting and/or catalyzing chemical reactions in the wells (col. 13, lines 56-62). In order for synthesis to occur in the wells of HOLLIS, the wells must inherently contain precursor molecules to be reacted, therefore claim 13 is anticipated. HOLLIS teaches that his arrays have electrodes integral to each test site (col. 14, lines 13-19), and teaches a method of synthesis of hybridized structures by applying electric potentials to each site via his electrodes (col. 13, line 64-col. 14, line 10), thereby anticipating claims 50 and 51.

### ***Allowable Subject Matter***

The following is an examiner's statement of reasons for allowance: the prior art does not teach or fairly suggest a method of combinatorial synthesis comprising reiterative steps of selectively biasing locations at which no reaction is to occur with the same charge as a reactive species, as recited in claims 41-43. HOLLIS ('708) teaches that an electric potential may be used to selectively bias locations at which a desired

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reaction is to occur, and teaches that a reverse bias can be *subsequently applied* to aid in washing or removal of unreacted species (col. 14, lines 10-14), but does not teach use of two different biases at different locations, specifically a "same charge" bias at a location where no reaction is desired.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (571) 272-0720. The examiner can normally be reached on Mon,Wed: 7-1:30; Tue,Thur: 7:30-6; Fri 7-3:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571)272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marjorie A. Moran  
Primary Examiner  
Art Unit 1631

*Marjorie A. Moran*  
11/28/05